

AMENDMENT

Application No. 09/894,558

Reply to Office Action of March 25, 2004

Attorney Docket: Case 6013D

Remarks

These remarks are presented in response to an Office Action dated March 25, 2004. It is noted that this Office Action was not issued until almost three years after the initial filing of this divisional application.

The present case was filed as a divisional application to now issued U.S. Patent No. 6,284,199. In turn, now issued U.S. Patent No. 6,503,470 (a method covering mercury removal using sulfide containing liquors) claimed priority from the '199 patent. Notably, both the '199 and '470 patents were searched in class 423/210 (Chemistry of Inorganic Compounds, modifying or removing component of normally gaseous mixture).

In a telephone interview in October of 2001 regarding the recently filed divisional application, a provisional election was made by attorney R.C. Baraona to pursue the Group I claims of the application, as described in the March 25, 2004 Office Action, directed toward apparatus claims 16-32 (Group II consisted of a sole method claim classified in class/subclass 423/210). It appears that this election was made without referring to the previous prosecution history, as the claims of the '199 patent are substantially similar to these elected claims.

Given the above and in view of the amendment to the claims proposed above, Applicant respectfully requests that the Office permit a shift in the claims from the invention of Group I to the invention of Group II, pursuant to MPEP §819.01. The Examiner will appreciate that the amended claims presented above reflect the method aspects of the previously considered apparatus claims of the '199 parent patent, so this Amendment will not broaden the scope of the invention or search which has already been performed. Also, given the amount of time that elapsed before receipt of the substantive Office Action on the merits of this case (an Office Action which contained nearly the same substantive claim rejections as the initial action received in the prosecution of the '199 patent), it is respectfully submitted that immediate consideration of these amended method claims should considerably reduce the amount of time required to complete prosecution of this case (instead of Applicants' having to file yet another divisional application and await examination). Finally, it is respectfully submitted that the shift should simplify the issues to the extent that the method is a more abstracted (and, in some respects, generalized) version of the already-searched apparatus claims. The Examiner and the Office are expressly authorized to take this type of action, in view of these factors, pursuant to *Ex parte Heritage*, Pat. No. 2,375,414, decided January 26, 1944.

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With respect to the claims themselves, the Examiner will appreciate that the elements substantially reflect inventive aspects of the allowed apparatus claims. Moreover, these elements are substantially similar to the previously cancelled method claims so that no new matter has been added.

Applicants respectfully submit that the Examiner's rejections of the claims under the double patenting rejection have been overcome since the apparatus claims have been cancelled. With respect to the obviousness type double patenting rejection, it is respectfully submitted that the present method claims should not be subjected to such a rejection since they are being pursued in response to a Restriction Requirement imposed by the Office. With respect to the Examiner's rejections of the now cancelled apparatus claims under 35 USC §103(a) it is respectfully submitted that the newly presented method claims identify patentably distinguishable process steps already determined to be patentable in the context of the allowed apparatus claims in the above-identified U.S. patents related to the present patent application. As such, it is respectfully submitted that newly presented method claims 38-47 are allowable over Martinelli et al. in view of JP 49-64557 and Venemark under 35 USC §103(a).

The formal amendments to the specification have also been made as requested by the Examiner. Additionally, the portion of the text describing Figure 6 has been amended to reflect the nature and identity of reference numeral 160 in a manner that is consistent with the originally submitted drawing.

In light of the foregoing, Applicants respectfully submit that, by this Amendment, the present application is now in condition for allowance, and such action is hereby requested.

Respectfully submitted,


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Date 25 June 2004

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